

REMARKS

In the Office Action, the Examiner rejected Claims 1-45, which are all of the pending claims, over the prior art. In particular, Claims 1-5, 10-20, 25-35 and 40-45 were rejected under 35 U.S.C. 102 as being fully anticipated by U.S. Patent 6,073,138 (de l'Etraz, et al.); and Claims 6-9, 21-24 and 36-39 were rejected under 35 U.S.C. 103 as being unpatentable over de l'Etraz, et al. in view of U.S. Patent 6,014,634 (Scroggie, et al.).

Claims 4, 5, 19, 20, 34 and 35 were further rejected under 35 U.S.C. 112 as being indefinite, and Claims 16 and 31 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Examiner also objected to the language used in Claims 16, 31, 35, 36 and 45.

Applicants herein ask that independent Claims 1, 16 and 31 be amended to better define the subject matters of these claims. Also, Claims 4, 5, 19, 20, 34 and 35 are being amended to address the rejection of these claims under 35 U.S.C. 112. The rejections of Claims 16 and 31 under 35 U.S.C. 101, and the objection to the language of Claims 16, 31, 35, 36 and 45 are respectfully traversed.

For the reasons below, the Examiner is asked to enter this Amendment, to reconsider and to withdraw the objection to the language of Claims 16, 31, 35, 36 and 45, and the rejection of Claims 16 and 31 under 35 U.S.C. 101. The Examiner is further requested to reconsider and to withdraw the rejection of Claims 4, 5, 19, 20, 34, 35 under 35 U.S.C. 112, the rejection of Claims 1-5, 10-20, 25-35 and 40-45 under 35 U.S.C. 102, and the rejection of Claims 6-9, 21-24 and 36-39 under 35 U.S.C. 103, and to allow Claims 1-45.

Applicants will discuss first the rejection under 35 U.S.C. 112 and 101 and the objection to the language of the claims, and then will discuss the rejections of the claims under 35 U.S.C. 102 and 103.

In rejecting Claims 4, 5, 19, 20, 34 and 35 under 35 U.S.C. 112, the Examiner objected to the term “blind analysis.” Applicants herein ask that these claims be amended to change “blind analysis” to “analysis.” As so amended, Claim 4, for example, now describes the limitation that the “predefined operation comprises analysis of data in a plurality of private data records.” This language is clear and definite, and well understood by those skilled in the art.

It is believed that the above-discussed changes overcome the Examiner’s objections to Claims 4, 5, 19, 20, 34 and 35; and the Examiner is thus asked to enter these amendments to these claims and to reconsider and to withdraw the rejection of Claims 4, 5, 19, 20, 34 and 35 under 35 U.S.C. 112.

The rejections of Claims 16 and 31 under 35 U.S.C. 101 are respectfully traversed because these claims are directed to statutory subject matter.

In the Office Action, the Examiner argued that Claims 16 and 31 do not list any hardware (i.e., computer) tied to the steps in order to operate the steps. The Examiner further argued that Claim 31 needs a computer or processor for the code to perform its functionality.

Claim 16 is a system claim directed to accessing data records in a private data set, and the claim describes structure needed to achieve that access. Specifically, this claim describes, among other elements, a separator, a logical link creator and a receiver. In the Office Action, the Examiner argued that these elements are “software only.” This is not the case. The present specification expressly states that the present invention may be embodied in a system. For instance, on page 1, paragraph 2; the specification expressly indicates that the present invention

relates to “a method, system and program product for allowing the viewer of a public data set to access related records in a private data set. Paragraph 6 of the specification also expressly indicates that the present invention may be embodied in a system. The elements positively set forth in Claim 16 are the elements of a system.

Claim 31 is directed to a computer program product comprising a computer readable medium having computer readable program code thereon. Claim 31 is thus directed to an article of manufacture within the meaning of 35 U.S.C. 101, and is thus statutory. This article of manufacture does not include a processor, and 35 U.S.C. 101 does not require that the claim to this article of manufacture include a processor.

In the Office Action, the Examiner argued that “computer code can’t exist on its own.” Importantly, Claim 31 does not define “computer code.” Instead, this claim defines a computer program product comprising a computer readable medium having computer readable program code therein. This “computer program product” is an article of manufacture within the meaning of 35 U.S.C. 101 and thus is directed to statutory subject matter.

For the reasons discussed above, Claims 16 and 31 define statutory subject matter within the meaning of 35 U.S.C. 101, and the Examiner is asked to reconsider and to withdraw the rejection of these claims under 35 U.S.C. 101.

As mentioned above, the Examiner also objected to the language of Claims 16, 31, 35, 36 and 45, and, in particular, the Examiner objected to the use of the word “for” in the bodies of these claims. The Examiner argued that the word indicates intended use and as such does not carry patentable weight. The Examiner further argued that the limitations following the phrase “for” describes only intended use but not necessarily required functionality of the claim.

The use of the word “for” in these claims is appropriate, and the functional limitations following the word “for” should be taken into account when determining the patentability of the claims. In particular, these functional limitations are not mere intended results.

Applicants have considerable discretion in defining their inventions. In the present case, the functional language following the word “for” is a positive limitation and indicates how a particular element operates in use. For example, Claim 16 describes “computer readable program code for separating a data record into a public data record stored in a public data set and a private data record stored in a private data set. The functional language after the word “for” does not describe merely a desired result, but instead describes the required operation of this computer readable program code. Accordingly, this functional language carries patentable weight.

Likewise, the functional language in Claims 31, 35, 36 and 45 describe the required operations of various elements, and these elements, when operated, must be operated in these ways in order for a particular computer program product to come within the scope of these claims.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the above-discussed objection to Claims 16, 31, 35, 36 and 45.

In addition, all of Claims 1-45 patentably distinguish over the prior art because the prior art does not disclose or suggest the way in which data from a private record is obtained, in response to a request from a user, and using information given by that user, including a logical link to the private data record, without the user having read access to the private data set, as described in independent Claims 1, 16 and 31.

For instance, de l'Etraz, which is the principal reference relied on by the Examiner to reject the claims, describes a system for proving relational patterns between entities, and in particular, provides a contact pathway that maps how to get to certain persons and organizations. This system includes a public information database containing data on the members of a plurality of entities in which a user has an interest in, and a private contact information database containing the personal contacts of the user. Software code is provided for accessing, in response to receiving a request from the user, the public and private databases, and this software code processes accessed information located in the databases in order to display a contact pathway.

One very important difference between the present invention and the procedure disclosed in de l'Etraz is that in the present invention, the user does not have read access to the private data base, while in de l'Etraz the user not only has access to the private database, the user is actually the one who provides the data to that private database.

The above-mentioned aspect of the present invention is very important. As discussed in detail in the present application, the present invention enables users, such as merchants, to use data from the private database without actually having read access to that data, thus maintaining the confidentiality of that private data. There is no reason to maintain this confidentiality with the procedure disclosed in de l'Etraz because, as indicated above, in de l'Etraz, the user is the one who actually provides the data to the private database.

The other references of record have been reviewed, and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

Specifically, Scroggie, et al. was cited for its disclosure of using certain information including a network address, and transmitting a message to that address. This reference does not disclose or suggest, though, accessing and using private date, in the manner described above, without giving the user/requestor read access to the private database.

Applicants herein ask that independent Claims 1, 16 and 31 be amended to emphasize the above-discussed aspect of the invention. More specifically, as amended herein, each of these claims describes the feature that a request is received from a user to perform a predefined operation using information from a private data record, where that request includes a logical link that links a public data record with that private data record. Each of these claims describes the further features of, in response to this request, finding the private data record using the information from the public data record received from the user in combination with the logical link, and performing the predefined operation using the private data record, and without the user having read access to the private data set.

Because of the above-discussed differences between Claims 1, 16 and 31 and the prior art, and because of the advantages associated with those differences, it cannot be said that any of the claims is anticipated by, or is obvious in view of, the prior art. Consequently, Claims 1, 16 and 31 patentably distinguish over the prior art and are allowable. Claims 2-25 are dependent from, and are allowable with, Claim 1. Similarly, Claims 17-29 are dependent from Claim 16 and are allowable therewith; and Claims 32-45 are dependent from, and are allowable with, Claim 31.

The amendments discussed above to Claims 1, 16 and 31 elaborate on features already described in the claims. For example, each of these claims presently describes the features of receiving the request from the user, finding the private data record, and performing the

predefined operation using the private data record. The claims are being amended herein to describe more expressly that the private data record is found in response to the request from the user, and that the predefined operation is performed without the user having access to the private data set. Accordingly, it is believed that entry of this Amendment is within the discretion of the Examiner, and such entry is respectfully requested.

For the reasons set forth above, the Examiner is asked to enter this Amendment, to reconsider and to withdraw the objection to the language of Claims 16, 31, 35, 36 and 45, and the rejection of Claims 16 and 31 under 35 U.S.C. 101. The Examiner is further requested to reconsider and to withdraw the rejection of Claims 4, 5, 19, 20, 34, 35 under 35 U.S.C. 112, the rejection of Claims 1-5, 10-20, 25-35 and 40-45 under 35 U.S.C. 102, and the rejection of Claims 6-9, 21-24 and 36-39 under 35 U.S.C. 103, and to allow Claims 1-45. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,

John S. Sensny
John S. Sensny
Registration No. 28,757
Attorney for Applicants

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza – Suite 300
Garden City, New York 11530
(516) 742-4343

JSS:jy